

Application No. 09/937,792  
Paper dated July 15, 2004  
In Reply to USPTO Correspondence of March 16, 2004  
Attorney Docket No. 2046-011632

### **REMARKS**

Claims 1-23 and 27-32 were pending in this application. Claims 9-13, 18, 23-27, and 29-32 are cancelled. Claims 14, 17 and 28 are amended. Not entered claims 29-32 are rewritten as newly presented claims 33-36, respectively, to comply with the Examiner's requirement as set forth in the Office Action. Claim 37 is new. No new subject matter is believed to have been added by these amendments. Therefore, claims 1-8, 14-17, 19-22, 28, and 33-37 remain in this application.

The Examiner has acknowledged that claims 1-8 are directed to allowable subject matter.

Claim 14 has been amended to clearly define that the wayside applicator bar includes a skirt that is positioned above the crown of the rail. Thus, the lubricating material is directed to the outside upper surface of a head or crown of a rail. Claims depending from independent claim 14 are believed to be patentable for the reasons discussed hereinabove in connection with amended independent claim 14. Reconsideration of the rejection of this claim is respectfully requested. Claim 17 requires that the skirt is either a flexible material or an elastomeric material. Claim 28 has been amended to correct a dependency resulting from the cancellation of claim 9. New claim 37 requires that the skirt be of metal.

### **35 U.S.C. § 103 Rejections**

Claims 11 and 18 stand rejected under 35 U.S.C. § 103(a) for obviousness based upon Watts (U.S. Patent No. 3,147,822) in view of Huck (U.S. Patent No. 2,489,182). In view of the above amendments and the following remarks, Applicants respectfully request reconsideration of these rejections. These claims have been canceled, and thus, the rejections in regard to claims 11 and 18 are moot.

Applicants understand that the Examiner is of the opinion that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Watts in view of the teachings of Huck to include a skirt made from an elastomeric

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material. However, the Applicants reiterate that there is no prior art of record that either a) discloses an apparatus for applying friction modifying material to a head of a rail or b) teaches or suggests the use of an elastomeric member adjacent a stationary exit end of a rail applicator. In any case, it would not be obvious to utilize the elastomeric member disclosed in Huck and apply it to the apparatus of Watts. The flexibility inherent in the elastomeric member of Huck allows the elastomeric member to be in continuous contact with the rail as the lubricant-applying means B moves downwardly due to contact with a train wheel against the plate 51. However, the elastomeric member of the present invention allows a train wheel to push the elastomeric member against the outside upper surface of the head of a rail as the wheel passes over the elastomeric member. Thus, this feature inherent in the flexibility aspect of utilizing an elastomeric member with respect to a traveled upper portion of the head of the rail is neither taught nor suggested by Huck or any other prior art of record. For the foregoing reasons, the Applicants believe that the subject matter of canceled claim 9, now partially incorporated into claim 14, is not rendered obvious by the Watts patent in view of the Huck patent. Reconsideration of the rejection of claim 14 is respectfully requested.

With respect to canceled claim 18, now partially incorporated into claim 14, the Examiner is of the opinion that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Watts in view of the teachings of Huck to position the skirt over a portion of the upper surface of a rail. As disclosed in Huck, the elastomeric material of the lubricant-applying means B allows the lubricating material to flow and/or be ejected against the *side* of the rail head (see column 4, lines 48-50). This is also the case with the other prior art of record. The present invention causes the lubricating material to be deposited onto a portion of the upper surface of the rail. Based upon the prior art of record, there is no motivation to position the skirt over any portion of the upper surface of the rail as this would cause the lubricating material to be deposited onto such portion, which is counter to having the lubricating material flow against the side of the rail head. In any case, the Applicants do not believe that Huck would form a proper basis in establishing an obviousness rejection for

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the limitation of canceled claim 18. For the foregoing reasons, the Applicants believe that the subject matter of canceled claim 18 is not rendered obvious by the Watts patent in view of the Huck patent. Reconsideration of the rejection of claim 14 is respectfully requested.

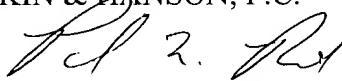
### **CONCLUSION**

Based on the foregoing amendments and remarks, reconsideration of the rejections and allowance of pending claims 1-8, 14-17, 19-22, 28 and 33-37 remain in this application.

Respectfully submitted,

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